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In re Application of SACCO et al
U.S. Application No.: 09/486,660
Int. Application No.: PCT/IT98/00231
Int. Filing Date: 11 August 1998
Priority Date: 28 August 1997
Attorney Docket No.: 471-129P (previously SCBREV-223)
For: TRANSGENIC ANIMALS FOR THE STUDY OF
BIOLOGICAL, PHYSICAL, AND CHEMICAL
TOXIC AGENTS

DECISION

This is in response to applicants' "Renewed Request for Status Under 37 CFR 1.42 and Renewed Petition Under 37 CFR 1.47(A)" filed 28 September 2001.

BACKGROUND

On 11 August 1998, applicants filed international application PCT/IT98/0023, which claimed priority of an earlier Italy application filed 28 August 1997. A copy of the international application was communicated to the USPTO from the International Bureau on 11 March 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 25 March 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 February 2000.

On 28 February 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the requisite basic national fee required by 35 U.S.C. 371(c)(1) and an unsigned declaration.

On 28 April 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 24 October 2000, applicants filed a request for status under 37 CFR 1.42, a petition under 37 CFR 1.47(a), a declaration executed by five of the six inventors, and declarations signed by certain legal representatives. The 24 October 2000 response requests that the present application be accepted for national stage processing without the signature of the guardian of one of the heirs of joint inventor Romeo Roncucci, who according to the petition is deceased.

On 30 April 2001, this office mailed a decision dismissing the request for status and petition on grounds of improper declarations and a failure to establish that guardian Anne Georgette Christiane Delachet refuses to sign the application papers.

On 28 September 2001, applicants filed the present response.

DISCUSSION

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." The response states that deceased inventor Romeo Roncucci has four heirs: Sylvie Roncucci, Rachele Roncucci, Regine Roncucci, and Roxanne Roncucci.

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

Sylvie Roncucci

The 24 October 2000 declaration signed by Sylvie Roncucci is defective for the reasons set forth in the 30 April 2001 decision. Furthermore, the declaration does not identify the citizenship of the legal representative as required by 37 CFR 1.497(b)(2).

Rachele Roncucci and Regine Roncucci

37 CFR 1.43 provides, "In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent." Applicants have submitted a declaration signed by Maria Novella Castagnoli, guardian of Rachele Roncucci and Regine Roncucci, who according to the response are minors.

The 24 October 2000 declaration signed by Maria Novella Castagnoli is defective for the reasons set forth in the 30 April 2001 decision. Furthermore, the declaration does not identify the citizenship of the legal representative as required by 37 CFR 1.497(b)(2).

Roxanne Roncucci

The renewed petition states that applicants have been unable to obtain the signature of Anne Georgette Christiane Delachet, guardian of Roxanne Roncucci, who according to the response is a minor.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by joint inventors Maria Grazia Sacco, Luigi Zecca, Libero Clerici, Paolo Vezzoni, and Peter Bromley. This declaration is improper because it does not identify Romeo Roncucci as an inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have demonstrated that a bona fide attempt was made to present a copy of the application papers (including specification, claims, drawings, and oath or declaration) to Ms. Delachet for signature. Specifically, a copy of the application papers was sent to Ms. Delachet on 25 September 2001 by courier (see affidavit of Peter Bromley, page 2). Courier records indicate that Ms. Delachet received the correspondence on 26 September 2001 (see copy of courier report for item number "4754533000").

However, applicants have not sufficiently established that Ms. Delachet's conduct constitutes a refusal to sign the application papers. The application papers included a cover letter which requested a response by 30 September 2001 (see translation of letter dated 25 September 2001). The renewed petition was filed on 28 September 2001, before the requested response period elapsed and merely two days after apparent receipt of the correspondence. It would be unreasonable to conclude that the failure of Ms. Delachet to respond within two days constitutes a refusal to sign the application papers.

With regard to item (3) above, the requisite petition fee has been provided.

With regard to item (4) above, the renewed petition states the last known address of Anne Georgette Christiane Delachet (see Bromley's affidavit).

CONCLUSION

For the reasons above, the request for status under 37 CFR 1.42 and the petition under 37 CFR 1.47(a) are DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Request for Status Under 37 CFR 1.42 and Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time pursuant to 37 CFR 1.136 are available.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


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